



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/453,800	12/03/1999	ANDREW WATSON	CIT101125	3066

27510 7590 04/07/2004
KILPATRICK STOCKTON LLP
607 14TH STREET, N.W.
SUITE 900
WASHINGTON, DC 20005

EXAMINER

KARMIS, STEFANOS

ART UNIT PAPER NUMBER

3624

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/453,800

Applicant(s)

WATSON, ANDREW

Examiner

Stefano Karmis

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application is in response to Appeal Brief filed on 17 March 2003.

Status of Claims

2. Claims 1-21 are under prosecution in this application

Summary of this Office Action

3. Applicant's Appeal Brief filed on 17 March 2003 has been fully considered. A new office action has been issued. Claims 1-21 are rejected under the prior art cited below and Applicant's request for allowance is respectfully denied.

Response to Amendment

4. In view of the appeal brief filed on 17 March 2003, PROSECUTION IS HEREBY REOPENED. A new ground of rejections is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

5. The Examiner acknowledges Applicant's Appeal Brief and the rejection in the previous office action, paper 10, has been withdrawn. Any remaining arguments are considered moot in view of the newly established grounds for rejection.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim1-11 and 14-21 rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. (hereinafter Walker) U.S. Patent 5,970,478.

Regarding independent claim 1, Walker discloses a method of offering account based services comprising providing a baseline offer for a first account based service (column 8, lines 6-20); receiving a first preference indicator signal (column 8, lines 39-48); adjusting the baseline offer so as to form a first modified offer based upon the first preference indicator signal (column 8, lines 39-48); adjusting the first account based service so as to form a second account based service based upon the first preference indicator signal and providing the first modified offer for the second account based service (column 8, lines 6-20).

Claim 2, a method of receiving a second preference indicator signal (column 8, lines 39-48); adjusting the baseline offer so as to form a first modified offer based upon the second preference indicator signal (column 8, lines 39-48); adjusting the second account based service so as to form a third account based service based upon the first preference indicator signal and providing the second modified offer for the third account based service (column 8, lines 6-20).

Claim 3, providing a list of available preference indicator choices along with providing the baseline offer (column 5, lines 56 thru column 6, line 6).

Claim 4, providing a list of available preference indicator choices along with providing the first offer (column 5, lines 56 thru column 6, line 6).

Art Unit: 3624

Claim 5, selecting the list of available preference indicator choices from a universe of possible preference indicators (column 5, lines 56 thru column 6, line 6).

Claim 6, receiving personal information and determining a qualification based on the personal information (column 5, lines 38-51 and column 6, lines 29-47).

Claim 7, using the qualification to select the list of available preference indicator choices from the universe of all possible preference indicator choices (column 5, line 39 thru column 6, line 6).

Claim 8, using the qualification to form the baseline offer (column 7, line 66 thru column 8, line 7).

Claim 9, not providing the baseline offer dependent upon the qualification (column 8, lines 54-67).

Claim 10, the qualification is a credit limit (column 5, lines 39-51).

Claim 11, the first and second account based services relate to a credit card account (column 5, lines 39-51).

Regarding independent claim 14, Walker discloses a computer system comprising a first computer wherein the first computer comprises a firewall module for determining security parameters (column 4, lines 14-34); an applicant module for collecting data (column 4, lines 41-49); a checker module for determining worthiness parameters (column 5, lines 39 thru column 6, line 7); an account services building module for receiving preference indicator signals indicative of features associated with an account-based service (column 4, lines 41-65).

Claim 15, a network coupled to the first computer (column 4, lines 27-34).

Claim 16, a second computer coupled to the network (column 4, lines 27-34 and Figure 3).

Claim 17, the network includes the World Wide Web (column 4, lines 27-34 and Figure 3).

Regarding independent claim 18, Walker discloses a method of offering account based services comprising providing a baseline offer for a first account based service (column 8, lines 6-20); providing a list of available features (column 5, line 57 thru column 6, line 7); receiving a first preference indicator signal (column 8, lines 39-48); adjusting the baseline offer so as to form a first modified offer based upon the first preference indicator signal (column 8, lines 39-48); adjusting the first account based service so as to form a second account based service based upon

the first preference indicator signal and providing the first modified offer for the second account based service (column 8, lines 6-20).

Claim 19, a method of receiving a second preference indicator signal (column 8, lines 39-48); adjusting the baseline offer so as to form a first modified offer based upon the second preference indicator signal (column 8, lines 39-48); adjusting the second account based service so as to form a third account based service based upon the first preference indicator signal and providing the second modified offer for the third account based service (column 8, lines 6-20).

Claim 20, a method of receiving a second preference indicator signal (column 8, lines 39-48); adjusting the baseline offer so as to form a first modified offer based upon the second preference indicator signal (column 8, lines 39-48); adjusting the second account based service so as to form a third account based service by deleting the first feature from the second account based service and by combining the second feature onto the second account based service so as to form the third account based service and providing the second modified offer for the third account based service (column 8, lines 6-20).

Claim 21, combining a second feature onto the first account based service so as to form the second account-based service (column 8, lines 6-20).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claim 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (hereinafter Walker) U.S. Patent 5,970,478.

Claims 12 and 13, Walker teaches the first and second account based services relate to a credit card account (column 5, lines 39-51). Walker fails to specify other types of accounts that could be implemented in the same process such as insurance and telecommunications accounts. Official Notice is taken that the procedure to open and manage an account is well known in the financial arts. Therefore it would have been obvious to one of ordinary skill in the art at the time

Art Unit: 3624

of the Applicant's invention to modify the teachings of Walker to include for other types of accounts that could be implemented in the same process such as insurance and telecommunications accounts because it provides an efficient system to manage an account and the accounts can be customized similar to the manner of the credit card accounts.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Cunningham, US Patent 6,014,645 Jan. 11, 2000. Real-time financial card application system.

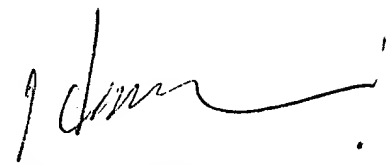
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully Submitted
Stefano Karmis
01 April 2004



HANI M. KAZIMI
PRIMARY EXAMINER